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Amendment After Final
Attorney Docket No. S63.2N-6531-US03

Remarks

This Amendment is in response to the Final Office Action dated July 2, 2004. In the Final Office Action, claims 23, 25, 26, 29, and 30 were rejected under 35 USC 103(a) as being unpatentable over Yan (5,843,172) in view of Solovay (5,769,884). Claims 23-30 and 32-40 were rejected under 35 USC 103(a) as being unpatentable over Richter in view of Solovay (5,769,884) and Saunders (5,780,807). Claims 25 and 34 have been canceled without prejudice or disclaimer as being duplicative. No new matter has been added.

Applicant addresses the rejections below under paragraph headings consistent with those of the Final Office Action.

(2)

The Final Office Action rejected claims 23, 25, 26, 29, and 30 under 35 USC 103(a) as being unpatentable over Yan (5,843,172) in view of Solovay (5,769,884). The Final Office Action acknowledges that Yan "does not disclose a tube having at least two different longitudinally spaced regions of different predetermined porosities and each region having the substantially the same porosity about its circumference"¹ and relies on Solovay to supply the missing teachings of Yan.

Applicant does not consider there to be motivation to make the proposed combination. MPEP 2143.01 provides that if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In this case, Yan (col. 4, lines 54-65) teaches the importance of consistent pore size and consistent distribution of pores in order to provide an even distribution of therapeutic agent. If the proposed combination were made, the resulting device would not have an even distribution of pores which Yan indicates is important for providing an even distribution of therapeutic agent. Therefore, there is no suggestion or motivation to make the proposed combination.

¹ The Final Office Action also asserts that Yan teaches a tube having at least two different longitudinal regions of different predetermined physical characteristics (different pore sizes located along the stent). Applicant disputes this assertion. The "longitudinally spaced regions of different predetermined physical characteristics" identified by the Final Office Action are merely the random variations which occur in sintering; there is nothing "predetermined" about these variations.

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Moreover, even if there were motivation to make the proposed combination, the combination of references would still not render the instant claims obvious.

First, to the extent that one of ordinary skill in the art were to combine the references, he would provide the Yan stent with the cover of Solovay. Providing a stent cover of different porosities to an already cut stent is not the same as providing a tube of at least two different longitudinally spaced regions of different predetermined porosities and then cutting a stent from the tube, as recited in the instant claims.

Second, even if one were to glean from Solovay a teaching of providing the different porosities in the stent itself rather than in the cover (a teaching which is absent from Solovay), the proposed combination would not teach whether the different porosities should be provided prior to cutting the stent or after cutting the stent. To that end, we note that Solovay teaches laser drilling as one means of providing a stent cover with the desired different porosities. Laser drilling the Yan stent prior to cutting the stent would likely result in an inefficient process as portions of the tube that will be discarded are drilled. Thus, in this case, one would not be led to provide a tube with the desired different porosities and then cut a stent. Rather one would cut the stent first and then provide it with the different porosities, contrary to the recitations of the claim.

At least for these reasons, Applicant believes that independent claim 23 is in condition for allowance and that those claims which draw their dependency from this claim are also in condition for allowance.

Applicant respectfully requests that the obviousness rejection of claims 23, 25, 26, 29, and 30 in light of Yan and Solovay be withdrawn.

(3)

In the Final Office Action claims 23-30 and 32-40 were rejected under 35 USC 103(a) as being unpatentable over Richter in view of Solovay (5,769,884) and Saunders (5,780,807).

Claim 23 requires providing a tube having at least two different longitudinally spaced regions of different predetermined porosities where each region has substantially the same porosity about its circumference, and subsequently cutting a stent from the tube.

Solovay teaches providing a stent covering with regions of different porosity. To

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the extent that one of ordinary skill in the art were presented with the above-mentioned references, at most he would provide the stent of Richter with the cover of Solovay. This would not, however, render obvious the claimed method. Providing a stent cover of different porosities to an already cut stent is not the same as providing a tube of at least two different longitudinally spaced regions of different predetermined porosities and then cutting a stent from the tube. Nothing in any of the applied references suggest providing the recited tube of different porosities and then cutting the stent from the tube.

Moreover, even if, for the sake of argument only, one were to take from Solovay a broad teaching that the stent itself may be provided with the different regions of different predetermined porosities, nevertheless, the proposed combination would not teach whether the different porosities should be provided prior to cutting the stent or after cutting the stent. To that end, we note that Solovay teaches laser drilling as one means of providing a stent cover with the desired porosity. Laser drilling prior to cutting the stent would likely result in an inefficient process as portions of the tube that will be discarded are drilled. Thus, in this case, one would not be led to provide a tube with the desired porosities and then cut a stent. Rather one would cut the stent first and then provide it with the different porosities, contrary to the recitations of the claim.

Saunders does not provide any of the missing teachings concerning porosity and the order of cutting the stent.

As such, withdrawal of the rejection as to claim 23 and claims dependent therefrom is respectfully requested.

Independent claim 32 includes the limitations of providing a tube having at least two different longitudinally spaced regions of different predetermined porosities and subsequently, cutting a plurality of openings in the tube to form a stent having multiple serpentine bands such that a first band has a different porosity than a second band.

Independent claim 32 and claims dependent therefrom are patentable over the proposed combination at least for the reasons discussed above with respect to claim 23.

Applicant respectfully requests that the obviousness rejection of claims 32-40 in light of Richter, Solovay, and Saunders be withdrawn.

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CONCLUSION

In view of the foregoing it is believed that the present application, with pending claims 23-30 and 32-40, is in condition for allowance. Early action to that effect is earnestly solicited.

Respectfully submitted,

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